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MAILED**FEB 24 2011****OFFICE OF PETITIONS**

In re Patent No. 6,000,658 :
Issue Date: 12/14/1999 :
Application Number: 09/059,994 : REQUEST FOR INFORMATION
Filing Date: 04/13/1998 :
For: AN IMPROVED TOILET PAPER :
DISPENSER :
:

This is a decision on the petition under 37 CFR 1.378(e),¹ filed on January 31, 2011, requesting reconsideration of a prior decision which refused to accept under § 1.378(b) the delayed payment of a maintenance fee for the above-referenced patent.

The petition is again dismissed.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this 2-month time limit can be granted under 37 CFR 1.136(a) or (b). No further fee is due for seeking reconsideration.

The patent issued on December 14, 1999. The first maintenance fee was timely paid. The second maintenance fee could have been paid from December 14, 2006 through June 14, 2007, or with a surcharge during the period from June 15, 2007 through December 14, 2007. Accordingly, the patent expired at midnight on December 14, 2007, for failure to timely remit the maintenance

¹ A grantable petition to accept a delayed maintenance fee payment under 37 CFR 1.378(b) must be include

(1) the required maintenance fee set forth in § 1.20(e) through (g);
(2) the surcharge set forth in § 1.20(i)(1); and
(3) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

fee. The petition under 37 CFR 1.378(b) filed on October 5, 2010, was dismissed on December 7, 2010. This request for reconsideration, accompanied by a check for \$400.00, was filed on January 31, 2011.

The Director may accept late payment of the maintenance fee if the delay is shown to the satisfaction of the Director to have been "unavoidable".² A patent owner's failure to pay a maintenance fee may be considered to have been "unavoidable" if the patent owner "exercised the due care of a reasonably prudent person."³ This determination is to be made on a "case-by-case basis, taking all the facts and circumstances into account."⁴ Unavoidable delay under 35 U.S.C. § 41(b) is measured by the same standard as that for reviving an abandoned application under 35 U.S.C. § 133.⁵ Under 35 U.S.C. § 133, the Director may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Director to have been "unavoidable". Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable.⁶ However, a petition to revive an application as unavoidably abandoned cannot be granted where a petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay.⁷ In view of In re Patent No. 4,409,763,⁸ this same standard will be applied to determine whether "unavoidable" delay within the meaning of 37 CFR 1.378(b) occurred.

This petition does not satisfy the requirement of 37 CFR 1.378(b)(3). The statements presented in the petition fail to satisfy the showing required to establish unavoidable delay within the meaning of 37 CFR 1.378(b).

² 35 U.S.C. § 41(c)(1).

³ Ray v. Lehman, 55 F.3d 606, 608-09 (Fed.Cir.), cert. denied, -- U.S. ---, 116 S.Ct. 304, L.Ed.2d 209 (1995).

⁴ Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982).

⁵ In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (PTO Comm'r 1988).

⁶ Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887) (the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913).

⁷ Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

⁸ 7 USPQ2d 1798, 1800 (Comm'r Pat. 1988), aff'd sub nom. Rydeen v. Quigg, 748 937 F.2d 623 (Fed. Cir. 1991) (table), cert. denied, 502 U.S. 1075 (1992).

Specifically, petitioner states that he relied on registered patent practitioner Michael R. McKenna for payment of the maintenance fee.

Petitioner further states:

By the time the second (maintenance) fee was due, I was reading in the newspaper, and saw on T.V. that a man went to his (McKenna's) office on the 23rd fl. and shot Mr. McKenna several times in the head and seriously injured his secretary. The man was apprehended by security and asked why he killed Mr. McKenna.... I called his office 6 mos. later and was told that Mr. McKenna's files would be turned over to another attorney. Call back later. When I called back, amazingly Mr. McKenna's secretary answered the phone. I told her how sorry I was about her and Mr. McKenna. She told me that it would take some time to go through Mr. McKenna's files. I believe I asked her about my maintenance fee. I think she told me I will be sent a letter. After that conversation I never called back.

Petitioner has further stated that he lacked sufficient funds to pay for the maintenance fee.

With regard to petitioner's assertion of financial incapacity, petitioner has failed to establish that the entire delay, from the date the maintenance fee was due until the date the initial petition was filed, was unavoidable. Specifically, it is noted that petitioner has provided copies of his bank statements covering the period from October 26, 2007, through December 24, 2010. The following statement dates and ending balance amounts are noted:

| Statement Date | Ending Balance Amount |
|-------------------|-----------------------|
| May 23, 2008 | \$1,642.42 |
| June 25, 2008 | \$2,783.67 |
| July 25, 2008 | \$1,612.67 |
| October 24, 2008 | \$3,007.72 |
| November 25, 2008 | \$2,155.46 |
| December 24, 2008 | \$3,978.15 |
| January 23, 2009 | \$1,862.22 |
| March 25, 2009 | \$1,448.78 |

| | |
|--------------------|------------|
| April 24, 2010 | \$2,108.05 |
| May 22, 2009 | \$1,628.71 |
| July 24, 2009 | \$1,745.96 |
| October 23, 2009 | \$1,573.84 |
| December 24, 2009 | \$2,618.56 |
| January 25, 2010 | \$2,697.54 |
| April 23, 2010 | \$2,333.98 |
| May 25, 2010 | \$1,608.82 |
| July 23, 2010 | \$1,252.22 |
| September 24, 2010 | \$1,658.73 |

As such, the showing of record is that, at least on the above-referenced dates, petitioner had sufficient funds in his bank account to pay the maintenance fee (\$1,180.00 if paid prior to October 2, 2008, \$1,240.00 if paid on or after October 2, 2008). Additionally, petitioner has not shown that the unavoidable surcharge of \$700.00 could not have been paid during this time. Rather than being "unavoidably" prevented from maintaining this patent in force, or more timely seeking reinstatement, petitioner made the business decision to subordinate more timely action in this patent to other financial and business interests, which mitigates away from a finding of unavoidable delay. That petitioner by a deliberately chosen course of action, subordinated the above-identified patent to other matters constitutes an intentional delay in seeking the maintenance or reinstatement of the above-identified patent; it does not represent the care or diligence that is generally used and observed by prudent and careful persons in relation to their most important business.⁹ Rather, a delay based upon deliberate business decisions, actions or inactions, which led to a purposeful failure to timely prosecute, is not unavoidable delay.¹⁰ There is no "sliding scale" based upon the priority given to this patent vis-a-vis other financial obligations by petitioner; the issue is solely whether the maintenance, or reinstatement, of the patent at issue was actually conducted with the care or diligence that is generally used and observed by prudent and careful persons in relation to their most important business. The financial analysis above indicates that above-identified patent was not considered by petitioner, as his most important business until October 5, 2010, and, consequently, the prosecution (i.e., maintenance and reinstatement) of the above-

⁹ See Smith v. Diamond, 209 USPQ 1091, 1093 (D.D.C. 1981).

¹⁰ See, Winkler v. Ladd, 221 F.Supp 550, 552, 138 USPQ 666, 667 (D.D.C. 1963) (bankruptcy trustee's business decision to forego incurring further prosecution expenses and to permit abandonment is binding and not unavoidable delay, when revival subsequently sought).

identified patent was conducted with significantly less care or diligence that is generally used and observed by prudent and careful persons in relation to their most important business between at least May 23, 2008 and October 5, 2010.

In summary, the showing of record is inadequate to establish unavoidable delay. Rather, than unavoidable delay, the showing of record is that petitioner's decided that the timely payment of the maintenance fee in this patent was not among petitioner's most important business. Rather, paying the maintenance fee for this patent was less important than other activities, and petitioner failed to take adequate precautions to ensure that maintenance fees were timely paid. As petitioner has not shown that it exercised the standard of care observed by a reasonable person in the conduct of his or her most important business, the petition will be dismissed.¹¹

With regard to period (1), a delay resulting from an error (e.g., a docketing error) on the part of an employee in the performance of a clerical function may provide the basis for a showing of "unavoidable" delay, provided it is shown that:

- (1) the error was the cause of the delay at issue;
- (2) there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance;
- (3) and the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care.¹²

An adequate showing requires:

- (A) Statements by all persons with direct knowledge of the circumstances surrounding the delay, setting forth the facts as they know them.
- (B) Petitioner must supply a thorough explanation of the docketing and call-up system in use and must identify the type of records kept and the person responsible for the maintenance of

¹¹ See note 6, supra.

¹² See MPEP 711.03(c)(III)(C)(2).

the system. This showing must include copies of mail ledgers, docket sheets, filewrappers and such other records as may exist which would substantiate an error in docketing, and include an indication as to why the system failed to provide adequate notice that a reply was due.

(C) Petitioner must supply information regarding the training provided to the personnel responsible for the docketing error, degree of supervision of their work, examples of other work functions carried out, and checks on the described work which were used to assure proper execution of assigned tasks.

The present petition lacks the showing required by (1), (2), and (3) above.

The Office is requesting further information to determine whether the maintenance fee was docketed by McKenna prior to his death, and whether another attorney was tracking the maintenance fee for payment thereof afterwards.

At the outset, it is noted that petitioner has not provided statements from all of the persons with direct knowledge of the circumstances surrounding the delay, setting forth the facts as they know them. Petitioner should endeavor to attain a statement from McKenna's former secretary, explaining the docketing system in place by McKenna at the time of his death. Further, petitioners must determine which, if any, registered patent practitioner assumed responsibility for the tracking and payment of the maintenance fee after McKenna's files were transferred. Statements of first hand knowledge setting forth the facts as they know them must be provided by all individuals with knowledge of the circumstances surrounding the delay in payment of the maintenance fee.

Further, petitioner must supply a thorough explanation of the docketing and call-up system in use and must identify the type of records kept and the person responsible for the maintenance of the system. This showing must include copies of mail ledgers, docket sheets, filewrappers and such other records as may exist which would substantiate an error in docketing, and include an indication as to why the system failed to provide adequate notice that a reply was due.

Lastly, petitioner must supply information regarding the training provided to the personnel responsible for the docketing error,

degree of supervision of their work, examples of other work functions carried out, and checks on the described work which were used to assure proper execution of assigned tasks.

Therefore, any showing of unavoidable delay must include a statement from petitioner's patent attorney, as well as any other attorney(s) of record during the period that payment of the maintenance fee was delayed, as to why action was not taken to timely submit the required maintenance fee while the patent was under that agent's control. Petitioner should send a letter (accompanied by a copy of this decision) to the registered patent practitioner who took over tracking and payment of the maintenance fee from McKenna by registered or certified mail, return receipt requested, indicating to the agent that the USPTO is requesting his assistance in determining the circumstances surrounding the expiration of this patent, and is specifically requesting the practitioner to provide a statement as to: (1) whether, and when, he first became aware that the first maintenance fee for this patent was due, and (2) why the maintenance fee was not timely submitted. Such statements should be accompanied by copies of any documents relevant to payment of the maintenance fee. In the event that the practitioner fails to provide a statement within a person (e.g., within one (1) month) specified in such letter, petitioner should submit a copy of such letter and the return receipt indicating its delivery to the patent attorney or agent with any petition for reconsideration under 37 CFR 1.378(e).

The above paragraph notwithstanding, petitioner is reminded that the failure of communication between an applicant and counsel is not unavoidable delay.¹³ Specifically, delay resulting from a lack of proper communication between a patent holder and a registered representative as to who bore the responsibility for payment of a maintenance fee does not constitute unavoidable delay within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b).¹⁴ Moreover, the Office is not the proper forum for resolving a dispute as to the effectiveness of communications between parties regarding the responsibility for paying a maintenance fee.¹⁵

¹³ In re Kim, 12 USPQ2d 1595 (Comm'r Pat. 1988).

¹⁴ See Ray v. Lehman, 55 F.3d 606, 610, 34 USPQ2d 1786, 1789 (Fed. Cir. 1995).

¹⁵ Id.

If petitioner is unable to locate the former secretary, petitioner should provide a showing of the attempts made to contact her and obtain a statement concerning the payment of the maintenance fee. Furthermore, petitioner must provide an affidavit or declaration of facts by the current administrative assistant, setting forth the facts as she knows them surrounding the delay in payment of the maintenance fee for the subject patent.

Additionally, petitioner must supply a thorough explanation of the docketing and call-up system in use and must identify the type of records kept and the person responsible for the maintenance of the system at McKenna's firm and at the successor law firm, if any. This showing must include copies of mail ledgers, docket sheets, filewrappers and such other records as may exist which would substantiate an error in docketing, and include an indication as to why the system failed to provide adequate notice that a reply was due. Petitioner should provide a copy of the spreadsheet and any other documentation utilized in the tracking and payment of maintenance fees.

In summary, the showing of record is inadequate to establish unavoidable delay. Petitioner has provided no evidence to substantiate a claim of docketing error. Rather, the showing of record is that petitioner failed to ensure that a reliable tracking system was in place such that the new administrative assistant could access the system and determine the due date for the payment of the maintenance fee for the subject patent. Rather, petitioners simply relied on the first administrative assistant, and were unable to access any of the information compiled by her after her resignation from the Company. As petitioner has not shown that it exercised the standard of care observed by a reasonable person in the conduct of his or her most important business, the petition will be dismissed.¹⁶

A reply to this communication should be filed within TWO (2) MONTHS to be considered timely. **No extensions of time are permitted under 37 CFR 1.136(a).**

¹⁶ See note 4, supra.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX: (571) 273-8300
Attn: Office of Petitions

By hand: Customer Service Window
Mail Stop Petition
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries should be directed to the undersigned at 571-272-3231.


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